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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,033	02/19/2002	Leon P. Janik	STAN/353/US	5972

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EXAMINER

SAVAGE, MATTHEW O

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 07/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/078,033

Applicant(s)

JANIK ET AL.

Examiner

Matthew O Savage

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-- Th MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the limitations of claims 9 and 17 lack antecedence in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 3 and 13, specifying the polymer in terms of trade names or trade marks is considered vague and indefinite since the formulation of the trade name or trade mark can be subjected to change over time.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8, 11-14, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown et al.

With respect to claim 1, Brown et al disclose a filter cartridge (e.g., an oil filter cartridge, see FIG. 1 and lines 64-67 of col. 2) including an upper shell portion 22 (see FIG. 3) having a first diameter and an upper surface 27 defining an axial opening, a lower shell 15 having a second diameter and connected to the upper shell portion by a peripheral roll seam, a filter element, a filter element secured within the connected upper and lower shell portions since the apparatus is an oil filter cartridge, and an elastomeric spring 10 protruding upwardly from the upper surface an axial distance of at least one tenth of an inch (see lines 49-60 of col. 5, the axial distance being equal to the width of the gasket (.406 inches) minus the depth of the groove (.282 inches) which is equal to .124 inches).

Concerning claims 2-3, Brown et al discloses the spring as being formed of a polymer that is nitrile rubber (see line 54 of col. 5).

As to claim 4, Brown et al disclose a shore hardness of between 55-75 (e.g., 70, see line 55 of col. 5).

Regarding claim 5, Brown et al disclose the spring as terminating in an axially projecting contact surface (e.g., a cylindrical contact surface).

Regarding claim 8, Brown et al discloses an elastomeric spring capable of the range of deflection of at least one tenth of an inch over which the elastomeric spring produces an an axial force of between 20-60 pounds since it is formed of the same material as disclosed by applicant (e.g., nitrile rubber having a shore A durometer hardness of 70 that is within applicants disclosed range of 55-75).

With respect to claims 11 and 12, Brown et al disclose a filter cartridge (e.g., an oil filter cartridge, see FIG. 1 and lines 64-67 of col. 2) including an upper shell portion 22 (see FIG. 3) having a first diameter and an upper surface 27 defining an axial opening, a lower shell 15 having a second diameter and connected to the upper shell portion by a peripheral roll seam, a filter element, a filter element secured within the connected upper and lower shell portions since the apparatus is an oil filter cartridge, and a spring 10 formed of a polymer material axially protruding from the upper surface, the elastomeric spring being capable of the range of deflection of at least one tenth of an inch over which the elastomeric spring produces an axial force of between 20-60 pounds since it is formed from the same material as disclosed by applicant (e.g., nitrile rubber having a shore A durometer hardness of 70 that is within applicants disclosed range of 55-75) and because the spring protrudes upwardly from the upper surface more than one tenth of an inch (see lines 49-60 of col. 5, the axial distance being equal to the width of the gasket (.406 inches) minus the depth of the groove (.282 inches) which is equal to .124 inches).

Concerning claims 13, Brown et al discloses the spring as being formed of a polymer that is nitrile rubber (see line 54 of col. 5).

Regarding claim 14, Brown et al disclose the spring as terminating in an axially projecting contact surface (e.g., a cylindrical contact surface).

As to claim 19, Brown et al disclose a shore hardness of between 55-75 (e.g., 70, see line 55 of col. 5).

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,364,121 in view of Paulsen. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons as follows:

Instant claim 1 is covered by claim 1 of the '121 patent with the exception of the limitation of the spring protruding from the upper surface an axial distance of at least one tenth of an inch. Paulsen discloses that it is known that the amount of force required to compress a tubular elastomeric spring increases with increasing deformation (see curve C₁ in FIG. 6 and lines 44-49 of col. 1). It would have been obvious to have modified the '121 apparatus so as to have included a spring protruding from the upper surface by an axial distance of one tenth of an inch in order to provide the amount of spring deformation required to produce the desired axial biasing force of the spring for a particular application since Paulsen discloses that the axial force of a tubular spring increases with increasing deformation.

Instant claims 2-3 are covered by claims 2-4 of the '121 patent.

Instant claim 4 is covered by claim 3 of the '121 patent.

Instant claims 5 and 6 are covered by claim 1 of the '121 patent.

With respect to instant claim 7, the '121 patent fails to specify between 6 and 24 spring columns, however, the duplication of such spring parts would have been obvious in order to provide the required multiplied spring effect / spring force required to optimize the spring for a particular application (see *St. Regis Paper Co. v Bemis Co., Inc.*, 193 USPQ 8, 11 (7th Cir. 1977)).

Concerning claim 8, '121 and Paulsen fail to specify the spring as having a range of deflection of at least one tenth of an inch to provide the recited axial biasing force of 20-60 pounds, however, such modification would have been obvious in order to provide the required axial biasing force for a particular application since Paulsen discloses that the axial force of a tubular spring increases with increasing deformation.

Instant claim 9 is covered by claim 1 of the '121 patent.

Instant claim 10 is covered by claim 5 of the '121 patent.

Instant claim 11 is covered by claim 1 of the '121 patent with the exception of the the spring as having a range of deflection of at least one tenth of an inch to provide the recited axial biasing force of 20-60 pounds. Paulsen discloses that it is known that the amount of force required to compress a tubular elastomeric spring increases with increasing deformation (see curve C₁ in FIG. 6 and lines 44-49 of col. 1). It would have been obvious to have modified the '121 apparatus so as to have included a spring having a range of deflection of at least one tenth of an inch in order to provide the

amount of spring deformation required to produce the axial biasing force of 20-60 pounds since Paulsen discloses that the axial force of a tubular spring increases with increasing deformation.

Concerning instant claim 12, the '121 patent fails to specify the limitation of the spring protruding from the upper surface an axial distance of at least one tenth of an inch, however, such a modification would have been obvious in order to provide the amount of deflection required to produce the recited biasing force since Paulsen discloses that the axial force of a tubular spring increases with increasing deformation.

Instant claim 12 is covered by claim 4 of the '121 patent.

Instant claims 14 and 15 are covered by claim 1 of the '121 patent.

With respect to instant claim 16, the '121 patent fails to specify between 6 and 24 spring columns, however, the duplication of such spring parts would have been obvious in order to provide the required multiplied spring effect / spring force required to optimize the spring for a particular application (see *St. Regis Paper Co. v Bemis Co., Inc.*, 193 USPQ 8, 11 (7th Cir. 1977)).

Instant claim 17 is covered by claim 1 of the '121 patent.

Instant claim 18 is covered by claim 5 of the '121 patent.

Instant claim 19 is covered by claim 3 of the '121 patent.


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is 703-308-3854. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda W. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Matthew O Savage
Primary Examiner
Art Unit 1723

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July 25, 2003